

BEST AVAILABLE COPYApplication Serial No.: 09/828,341
Art Unit: 2624**REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed April 11, 2006. Claims 1-35 remain pending in the present application. Reconsideration and allowance of the application and pending claims are respectfully requested.

1. Response To Rejections of Claims Under 35 U.S.C. §103**a. Moscato in view of Kitabatake**

Claims 1-5, 10-21, and 26-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moscato* (U.S. Patent No. 6,335,978) in view of *Kitabatake* (U.S. Patent No. 6,099,181). Claim 6-9 and 22-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moscato* in view of *Kitabatake* in further view of *Schwenk* (U.S. Patent No. 6,590,995). It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicants respectfully traverse the rejections.

i. Claim 1

As provided in independent claim 1, Applicants claim:

A system for verifying a document comprising:
first means for providing a first electronic image of a document;
second means for providing a second electronic image of a document,
said second electronic image being a scanned copy of a printed version of
said first electronic image; and
third means for comparing said first and second electronic images and
providing an output in response thereto, *wherein said output signifies
whether said printed version of said first electronic image is a successful
print and causes a prohibition of additional printed versions from being
produced from another print request if said output is signified to be a
successful print.*

(Emphasis added).

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Moscato* in view of *Kitabatake* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a

Application Serial No.: 09/828,341
Art Unit: 2624

successful print and causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print," as recited and emphasized above in claim 1.

The Office Action acknowledges that *Moscato* "fails to teach and/or suggest a prohibition of printing another copy if a printed page has been successfully printed." Office Action, page 2. In making the rejection, the Office Action alleges that *Kitabatake* "teaches a prohibition of printing another copy if a first printed copy is successfully printed (reprinting is prohibited if the printed page has been successful printed, col. 2, lines 8-11, col. 11, lines 18-47). Office Action, page 3.

Applicants submit that *Kitabatake* should also have to teach the feature of providing an output in response to a comparison of first and second electronic images, "wherein said output signifies whether said printed version of said first electronic image is a successful print." It is this output that causes a prohibition of additional images from being produced. Without at least the teaching of this feature, the proposed combination fails to teach or suggest the claimed subject matter of claim 1, since *Moscato* fails to teach or suggest this feature either.

With regard to *Kitabatake*, it seemingly teaches "a technique of precisely determining when a recording medium is ejected out of a printer." Col. 1, lines 64-67. In this way, "the status of the [transporting] process for each page can be precisely determined thereby making it possible to properly restart the process for each page after recovery from [a paper] jam, thus preventing an already-printed page from being printed on again and preventing a not-yet-printed page from being skipped without being printed." Col. 2, lines 5-11.

Kitabatake does not appear to teach or suggest that an output, in response to comparing first and second electronic images, signifies whether a printed version of the first electronic image is a successful print and causes a prohibition of additional printed versions from being produced. Rather, *Kitabatake* seemingly prohibits a printed page from being reproduced in a recovery from a print jam if it has been surmised that the page had been printed prior to the print jam.

Thus, *Moscato* in view of *Kitabatake* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced."

Further, the proposed combination fails to teach or suggest the additional feature of causing a prohibition of additional printed versions from being produced "from another print

Application Serial No.: 09/828,341
Art Unit: 2624

request if said output is signified to be a successful print," as recited in the claim. (Emphasis added) For example, *Kitabatake* teaches that an already-printed page for a current print request is not printed again, but allows for an already-printed page to be printed in another print request.

For at least these reasons, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Moscato* in view of *Kitabatake* has not been made. The rejection should be withdrawn for at least these reasons.

ii. Claims 2-20

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-20 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-20 contain all the elements and features of independent claim 1 and the *Schwenk* reference does not cure the deficiencies of the *Moscato* and *Kitabatake* references. For at least this reason, the rejections of claims 2-20 should be withdrawn.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 2-20, these dependent claims recite further features/steps and/or combinations of features/steps (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

Regarding the *Schwenk* reference, Applicants believe that the reference (and the other references of the proposed combination) fails to teach or suggest the feature, among others, of providing a fingerprint output signal, as described in the claims 8-9.

The rejections should be withdrawn for at least these reasons.

iii. Claim 21

As provided in independent claim 21, Applicants claim:

A system for verifying a printed document comprising:
a computer for providing a first electronic image of a document;
a printer coupled to said computer;
a scanner adapted to scan a document printed by said printer to provide a second electronic image of said document, said second electronic image being a scanned copy of a printed version of said first electronic image; and
software for comparing said first and second electronic images and providing an output in response thereto, *wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being*

Application Serial No.: 09/828,341
Art Unit: 2624

produced from another print request if said output is signified to be a successful print.

(Emphasis added).

Applicants respectfully submit that independent claim 21 is allowable for at least the reason that *Moscato* in view of *Kitabatake* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print," as recited and emphasized above in claim 21.

The Office Action acknowledges that *Moscato* "fails to teach and/or suggest a prohibition of printing another copy if a printed page has been successfully printed." Office Action, page 2. In making the rejection, the Office Action alleges that *Kitabatake* "teaches a prohibition of printing another copy if a first printed copy is successfully printed (reprinting is prohibited if the printed page has been successful printed, col. 2, lines 8-11, col. 11, lines 18-40). Office Action, page 3. Applicants submit that *Kitabatake* should also have to teach the feature of providing an output in response to a comparison of first and second electronic images, "wherein said output signifies whether said printed version of said first electronic image is a successful print." It is this output that causes a prohibition of additional images from being produced. Without at least the teaching of this feature, the proposed combination fails to teach or suggest the claimed subject matter of claim 21, since *Moscato* fails to teach or suggest this feature either.

With regard to *Kitabatake*, it seemingly teaches "a technique of precisely determining when a recording medium is ejected out of a printer." Col. 1, lines 64-67. In this way, "the status of the [transporting] process for each page can be precisely determined thereby making it possible to properly restart the process for each page after recovery from [a paper] jam, thus preventing an already-printed page from being printed on again and preventing a not-yet-printed page from being skipped without being printed." Col. 2, lines 5-11.

Kitabatake does not appear to teach or suggest that an output, in response to comparing first and second electronic images, signifies whether a printed version of the first electronic image is a successful print and causes a prohibition of additional printed versions from being produced. Rather, *Kitabatake* seemingly prohibits a printed page from being reproduced in a recovery from a print jam if it has been surmised that the page had been printed prior to the print jam.

Application Serial No.: 09/828,341

Art Unit: 2624

Thus, *Moscato* in view of *Kitabatake* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced."

Further, the proposed combination fails to teach or suggest the additional feature of causing a prohibition of additional printed versions from being produced "from another print request if said output is signified to be a successful print," as recited in the claim. (Emphasis added) For example, *Kitabatake* teaches that an already-printed page for a current print request is not printed again, but allows for an already-printed page to be printed in another print request.

For at least these reasons, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Moscato* in view of *Kitabatake* has not been made. The rejection of claim 21 should be withdrawn for at least these reasons.

iv. Claims 22-34

Because independent claim 21 is allowable over the cited art of record, dependent claims 22-34 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-34 contain all the elements and features of independent claim 21 and the *Schwenk* reference does not cure the deficiencies of the *Moscato* and *Kitabatake* references. For at least this reason, the rejections of claims 23-34 should be withdrawn.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 22-34, these dependent claims recite further features/steps and/or combinations of features/steps (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

Regarding the *Schwenk* reference, Applicants believe that the reference (and the other references of the proposed combination) fails to teach or suggest the feature, among others, of providing a fingerprint output signal, as described in the claims 24-25.

The rejections should be withdrawn for at least these reasons.

v. Claim 35

As provided in independent claim 35, Applicants claim:

A method for verifying a document including the steps of:
providing a first electronic image of a document;

Application Serial No.: 09/828,341
Art Unit: 2624

providing a second electronic image of a document, said second electronic image being a scanned copy of a printed version of said first electronic image; and

comparing said first and second electronic images and providing an output in response thereto, *wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print.*

(Emphasis added).

Applicants respectfully submit that independent claim 35 is allowable for at least the reason that *Moscato* in view of *Kitabatake* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print," as recited and emphasized above in claim 35.

The Office Action acknowledges that *Moscato* "fails to teach and/or suggest a prohibition of printing another copy if a printed page has been successfully printed." Office Action, page 2. In making the rejection, the Office Action alleges that *Kitabatake* "teaches a prohibition of printing another copy if a first printed copy is successfully printed (reprinting is prohibited if the printed page has been successful printed, col. 2, lines 8-11, col. 11, lines 18-45). Office Action, page 3. Applicants submit that *Kitabatake* should also have to teach the feature of providing an output in response to a comparison of first and second electronic images, "wherein said output signifies whether said printed version of said first electronic image is a successful print." It is this output that causes a prohibition of additional images from being produced. Without at least the teaching of this feature, the proposed combination fails to teach or suggest the claimed subject matter of claim 35, since *Moscato* fails to teach or suggest this feature either.

With regard to *Kitabatake*, it seemingly teaches "a technique of precisely determining when a recording medium is ejected out of a printer." Col. 1, lines 64-67. In this way, "the status of the [transporting] process for each page can be precisely determined thereby making it possible to properly restart the process for each page after recovery from [a paper] jam, thus preventing an already-printed page from being printed on again and preventing a not-yet-printed page from being skipped without being printed." Col. 2, lines 5-11.

Application Serial No.: 09/828,341

Art Unit: 2624

Kitabatake does not appear to teach or suggest that an output, in response to comparing first and second electronic images, signifies whether a printed version of the first electronic image is a successful print and causes a prohibition of additional printed versions from being produced. Rather, *Kitabatake* seemingly prohibits a printed page from being reproduced in a recovery from a print jam if it has been surmised that the page had been printed prior to the print jam.

Thus, *Moscato* in view of *Kitabatake* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced."

Further, the proposed combination fails to teach or suggest the additional feature of causing a prohibition of additional printed versions from being produced "from another print request if said output is signified to be a successful print," as recited in the claim. (Emphasis added) For example, *Kitabatake* teaches that an already-printed page for a current print request is not printed again, but allows for an already-printed page to be printed in another print request.

For at least these reasons, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Moscato* in view of *Kitabatake* has not been made. The rejection of claim 35 should be withdrawn for at least these reasons.

p. Moscato in view of Manchala

Claims 1-5, 10-21, and 26-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moscato* (U.S. Patent No. 6,335,978) in view of *Manchala* (U.S. Patent No. 6,088,119). Claim 6-9 and 22-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moscato* in view of *Manchala* in further view of *Schwenk* (U.S. Patent No. 6,590,995). It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicants respectfully traverse the rejections.

Application Serial No.: 09/828,341
Art Unit: 2624

i. Claim 1

As provided in independent claim 1, Applicants claim:

A system for verifying a document comprising:

first means for providing a first electronic image of a document;

second means for providing a second electronic image of a document,
said second electronic image being a scanned copy of a printed version of
said first electronic image; and

third means for comparing said first and second electronic images and
providing an output in response thereto, *wherein said output signifies
whether said printed version of said first electronic image is a successful
print and causes a prohibition of additional printed versions from being
produced from another print request if said output is signified to be a
successful print.*

(Emphasis added).

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Moscato* in view of *Manchala* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print," as recited and emphasized above in claim 1.

The Office Action acknowledges that *Moscato* "fails to teach and/or suggest a prohibition of additional printed version from being produced if said output is signified to be a successful print." Office Action, page 2. The Office Action alleges that *Manchala* cures the deficiencies of the *Moscato* reference by disclosing this feature. Applicants submit, however, that *Manchala* should also have to teach the feature of providing an output in response to a comparison of first and second electronic images, "wherein said output signifies whether said printed version of said first electronic image is a successful print." It is this output that causes a prohibition of additional images from being produced. Without at least the teaching of this feature, the proposed combination fails to teach or suggest the claimed subject matter of claim 1, since *Moscato* fails to teach or suggest this feature either.

In making the rejection, the Office Action also alleges that *Manchala* "teaches a prohibition of additional printed version from being produced if said output is signified to be a successful print (reprinting is prohibited if the first printed check is successful printed, col. 2, lines 30 to col. 3, lines 35 and col. 5, lines 1-10)." Page 8. Applicants have reviewed the *Manchala* reference and disagree with the Office Action for at least the following reasons.

Application Serial No.: 09/828,341
Art Unit: 2624

Manchala appears to teach at most a system for ensuring that a defective check is destroyed before a new check is printed. See col. 1, lines 50-53. When a print operation commences for printing a new check, a "no-print flag" is enabled. See col. 5, lines 3-5. While this flag is enabled, another copy of the check may not be printed. To disable the "no-print flag," one of the following events must occur: (1) a shredder disables the no-print flag in the process of shredding the printed check, col. 3, lines 1-6; or (2) the "proper authorities" disable the no-print flag using a client application or the control panel of the printer. Col. 3, lines 19-47.

Manchala does not appear to teach or suggest that an output, in response to comparing first and second electronic images, signifies whether a printed version of the first electronic image is a successful print and causes a prohibition of additional printed versions from being produced. Rather, *Manchala* seemingly prohibits the subject of any print job from having additional prints made, regardless if the print job resulted in a print jam, a clean copy, a bad copy resulting from low toner, etc. Therefore, to enable further copies to be made, either the previous version has to be shredded using a shredding device or the "proper authorities" have to override and reset a "no-print flag."

Thus, *Moscato* in view of *Manchala* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print." (Emphasis added). As a result, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Moscato* in view of *Manchala* has not been made.

The rejection should be withdrawn for at least this reason alone.

ii. Claims 2-20

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-20 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-20 contain all the elements and features of independent claim 1 and the *Schwenk* reference does not cure the deficiencies of the *Moscato* and *Manchala* references. For at least this reason, the rejections of claims 2-20 should be withdrawn.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 2-20, these dependent claims recite further features/steps and/or combinations of features/steps (as

Application Serial No.: 09/828,341
Art Unit: 2624

is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

Regarding the *Schwenk* reference, Applicants believe that the reference (and the other references of the proposed combination) fails to teach or suggest the feature, among others, of providing a fingerprint output signal, as described in the claims 8-9.

The rejections should be withdrawn for at least these reasons.

iii. Claim 21

As provided in independent claim 21, Applicants claim:

A system for verifying a printed document comprising:
a computer for providing a first electronic image of a document;
a printer coupled to said computer;
a scanner adapted to scan a document printed by said printer to provide a second electronic image of said document, said second electronic image being a scanned copy of a printed version of said first electronic image; and
software for comparing said first and second electronic images and providing an output in response thereto, *wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print.*

(Emphasis added).

Applicants respectfully submit that independent claim 21 is allowable for at least the reason that *Moscato* in view of *Manchala* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print," as recited and emphasized above in claim 21.

The Office Action acknowledges that *Moscato* "fails to teach and/or suggest a prohibition of additional printed version from being produced if said output is signified to be a successful print." Office Action, page 2. The Office Action alleges that *Manchala* cures the deficiencies of the *Moscato* reference by disclosing this feature. Applicants submit, however, that *Manchala* should also have to teach the feature of providing an output in response to a comparison of first and second electronic images, "wherein said output signifies whether said printed version of said first electronic image is a successful print." It is this output that causes a prohibition of additional images from being produced. Without at least

Application Serial No.: 09/828,341
Art Unit: 2624

the teaching of this feature, the proposed combination fails to teach or suggest the claimed subject matter of claim 21, since *Moscato* fails to teach or suggest this feature either.

In making the rejection, the Office Action also alleges that *Manchala* "teaches a prohibition of additional printed version from being produced if said output is signified to be a successful print (reprinting is prohibited if the first printed check is successful printed, col. 2, lines 30 to col. 3, lines 35 and col. 5, lines 1-10)." Page 8. Applicants have reviewed the *Manchala* reference and disagree with the Office Action for at least the following reasons.

Manchala appears to teach at most a system for ensuring that a defective check is destroyed before a new check is printed. See col. 1, lines 50-53. When a print operation commences for printing a new check, a "no-print flag" is enabled. See col. 5, lines 3-5. While this flag is enabled, another copy of the check may not be printed. To disable the "no-print flag," one of the following events must occur: (1) a shredder disables the no-print flag in the process of shredding the printed check, col. 3, lines 1-6; or (2) the "proper authorities" disable the no-print flag using a client application or the control panel of the printer. Col. 3, lines 19-47.

Manchala does not teach or suggest that an output, in response to comparing first and second electronic images, signifies whether a printed version of the first electronic image is a successful print and causes a prohibition of additional printed versions from being produced. Rather, *Manchala* seemingly prohibits the subject of any print job from having additional prints made, regardless if the print job resulted in a print jam, a clean copy, a bad copy resulting from low toner, etc. Therefore, to enable further copies to be made, either the previous version has to be shredded using a shredding device or the "proper authorities" have to override and reset a "no-print flag."

Thus, *Moscato* in view of *Manchala* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print." (Emphasis added). As a result, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Moscato* in view of *Manchala* has not been made.

The rejection should be withdrawn for at least this reason alone.

Application Serial No.: 09/828,341
Art Unit: 2624

iv. Claims 22-34

Because independent claim 21 is allowable over the cited art of record, dependent claims 22-34 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-34 contain all the elements and features of independent claim 21 and the *Schwenk* reference does not cure the deficiencies of the *Moscato* and *Manchala* references. For at least this reason, the rejections of claims 23-34 should be withdrawn.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 22-34, these dependent claims recite further features/steps and/or combinations of features/steps (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

Regarding the *Schwenk* reference, Applicants believe that the reference (and the other references of the proposed combination) fails to teach or suggest the feature, among others, of providing a fingerprint output signal, as described in the claims 24-25.

The rejections should be withdrawn for at least these reasons.

v. Claim 35

As provided in independent claim 35, Applicants claim:

A method for verifying a document including the steps of:
providing a first electronic image of a document;
providing a second electronic image of a document, said second electronic image being a scanned copy of a printed version of said first electronic image; and
comparing said first and second electronic images and providing an output in response thereto, *wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print.*

(Emphasis added).

Applicants respectfully submit that independent claim 35 is allowable for at least the reason that *Moscato* in view of *Manchala* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print," as recited and emphasized above in claim 35.

Application Serial No.: 09/828,341
Art Unit: 2624

The Office Action acknowledges that *Moscato* "fails to teach and/or suggest a prohibition of additional printed version from being produced if said output is signified to be a successful print." Office Action, page 2. The Office Action alleges that *Manchala* cures the deficiencies of the *Moscato* reference by disclosing this feature. Applicants submit, however, that *Manchala* should also have to teach the feature of providing an output in response to a comparison of first and second electronic images, "wherein said output signifies whether said printed version of said first electronic image is a successful print." It is this output that causes a prohibition of additional images from being produced. Without at least the teaching of this feature, the proposed combination fails to teach or suggest the claimed subject matter of claim 35, since *Moscato* fails to teach or suggest this feature either.

In making the rejection, the Office Action also alleges that *Manchala* "teaches a prohibition of additional printed version from being produced if said output is signified to be a successful print (reprinting is prohibited if the first printed check is successful printed, col. 2, lines 30 to col. 3, lines 35 and col. 5, lines 1-10)." Page 8. Applicants have reviewed the *Manchala* reference and disagree with the Office Action for at least the following reasons.

Manchala appears to teach at most a system for ensuring that a defective check is destroyed before a new check is printed. See col. 1, lines 50-53. When a print operation commences for printing a new check, a "no-print flag" is enabled. See col. 5, lines 3-5. While this flag is enabled, another copy of the check may not be printed. To disable the "no-print flag," one of the following events must occur: (1) a shredder disables the no-print flag in the process of shredding the printed check, col. 3, lines 1-6; or (2) the "proper authorities" disable the no-print flag using a client application or the control panel of the printer. Col. 3, lines 19-47.

Manchala does not teach or suggest that an output, in response to comparing first and second electronic images, signifies whether a printed version of the first electronic image is a successful print and causes a prohibition of additional printed versions from being produced. Rather, *Manchala* seemingly prohibits the subject of any print job from having additional prints made, regardless if the print job resulted in a print jam, a clean copy, a bad copy resulting from low toner, etc. Therefore, to enable further copies to be made, either the previous version has to be shredded using a special shredding device or the "proper authorities" have to override and reset a "no-print flag."

Thus, *Moscato* in view of *Manchala* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and

Application Serial No.: 09/828,341
Art Unit: 2624

causes a prohibition of additional printed versions from being produced from another print request if said output is signified to be a successful print." (Emphasis added). As a result, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Molcato* in view of *Manchala* has not been made.

The rejection should be withdrawn for at least this reason alone.

CONCLUSION

For at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,


Charles W. Griggers, Reg. No. 47,283

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☒ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.